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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/038,864

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Hiroaki Sato

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07/19/2004

BANNER & WITCOFF

1001 G STREET N W

SUITE 1100

WASHINGTON, DC 20001

EXAMINER

NGUYEN, DUC M

ART UNIT

PAPER NUMBER

2685

6

DATE MAILED: 07/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/038,864

Applicant(s)

SATO, HIROAKI

Examiner

Duc M. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Objections

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim 39 has been renumbered to 38.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims **1-4, 6-7, 11-14, 16-17, 21-23, 25-26, 30-35** are rejected under 35 U.S.C. 102(e) as being anticipated by **Vu (US 6,185,436)**.

Regarding claim **1**, **Vu** discloses a mobile communication apparatus for communicating with a network selectively utilizing a plurality of IC units (SIM cards) which would include all the claimed limitations (see Abstract), comprising :

- a detector configured to detect each of IC units connect to the handset (see col. 3, line 15 – col. 4, line 5, wherein it is clear that the electrical contact from the SIM card insertion would trigger a detection);
- an activator (executing program) configured to activate at least one IC as claimed (see col. 3, line 63 - col. 4, line 6);
- a controller (processor) configured to inform the network of data in the activated IC unit (see col. 3, lines 56-60).

Regarding claim **2**, the claim is rejected for the same reason as set forth in claim 1 above. In addition, **Vu** discloses two or more SIM cards can be activated concurrently in the handset (see col. 2, lines 18-20 and col. 5, lines 15-27).

Regarding claim **3**, the claim is rejected for the same reason as set forth in claim 1 above. In addition, **Vu** discloses the initiate establishment as claimed (see col. 3, lines 56-63).

Regarding claim **4**, the claim is rejected for the same reason as set forth in claim 1 above. In addition, **Vu** discloses the selector as claimed (see col. 3, lines 56-63).

Regarding claim **6**, the claim is rejected for the same reason as set forth in claim 4 above. In addition, **Vu** discloses the selector select an activated SIM based on time information as claimed (see col. 7, lines 8 – 55).

Regarding claim **7**, the claim is rejected for the same reason as set forth in claim 4 above. In addition, **Vu** discloses the selector select an activated SIM based on broadcast information as claimed (see col. 5, lines 5-14).

Regarding claims **11-14, 16-17**, they are interpreted and rejected for the same reason as set forth in claims 1-4, 6-7 above, respectively.

Regarding claims **21-23, 25-26, 30-35**, they are interpreted and rejected for the same reason as set forth in claims 1-4, 6-7 above.

3. Claims **1-6, 11-16, 21-25, 30-34** are rejected under 35 U.S.C. 102(e) as being anticipated by **Tayloe (US 5,987,325)**.

Regarding claims **1-6, Tayloe** discloses a mobile communication apparatus for communicating with a network selectively utilizing a plurality of IC units (SIM cards) which would include all the claimed limitations (see Abstract), comprising :

- a detector configured to detect each of IC units connect to the handset (see Fig. 3, block 302 and col. 5, lines 41-51);
- an activator configured to activate more than one IC as claimed (see Fig. 3, block 305 and col. 5, lines 41-51);
- a controller (an inherent feature of mobile) configured to inform the network of data in the activated IC unit (see Fig. 3, block 306 and col. 5, lines 41-51);
- a selector based on time as claimed (see col. 5, lines 41-51);
- deactivate the removed or non-select SIM as claimed (see Fig. 3 and col. 5, lines 41-51);

Regarding claims **11-16, 21-25, 30-34**, they are interpreted and rejected for the same reason as set forth in claims 1-6 above.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims **8, 18, 27, 36** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Vu** in view of **Blakeley** (US **6,085,085**).

Regarding claim **8**, **Vu** discloses all the claimed limitations, see claim 1 above, except for the location indicator. However, it is noted that since the broadcast data in **Vu** comprises PLMN ID or cell ID (see col. 5, lines 5-10 and col. 8, lines 15-35), it is clear that such IDs could be used to indicate a location of the mobile as disclosed by **Blakeley** (see col. 3, lines 8-15). Therefore, the claimed limitation is made obvious by **Vu** and **Blakeley** for using a cell broadcast ID to approximate the location of a mobile without the need of a GPS or a location calculator.

Regarding claims **18, 27, 36**, they are interpreted and rejected for the same reason as set forth in claim 8 above.

5. Claims **9-10, 19-20, 28-29, 37-38** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Vu** in view of **Hirsch** (US **6,085,08**).

Regarding claims **9-10**, the claim is rejected for the same reason as set forth in claim 7 above. In addition, **Vu** discloses the SIM data comprising a table of PLMN ID or cell ID (see col. 5, lines 5-10 and col. 8, lines 15-35), which would obviously comprise a

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home location code so that the preferred home PLMN can be selected for cost saving (i.e, avoid roaming charge). However, **Vu** is silent on the country code. However, it is noted that such country code is a component of the GSM specification as disclosed by **Hirsch** (see col. 2, line 60 – 67). Therefore, it would have been obvious to one skilled in the art to combine the above teachings of **Vu** and **Hirsch** for providing a country code as claimed, so that a mobile station located in an overlap coverage area of two cells having different country codes would be able to select the cell providing the least cost, for cost saving such as avoid roaming charge.

Regarding claims **19-20, 28-29, 37-38**, they are interpreted and rejected for the same reason as set forth in claims 9-10 above.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- **Stadelmann et al** (US Patent Number 6,738,622), Roaming method and devices appropriate therefor.

- **Mueller** (US 6,185,413), Mobile station having a cost-efficient call management method and system.

- **Lee et al** (US 5,974,328), Rapid system access and registration in mobile phone system.

- **Agre et al** (US 6,208,857), Method and apparatus for performing position and preference-based service selection in a mobile telephone system.

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7. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

703-872-9314 (for formal communications intended for entry)

(for informal or draft communications, please label PROPOSED or DRAFT)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc M. Nguyen whose telephone number is 703-306-4531. The examiner can normally be reached on Monday-Thursday (9:30 AM – 5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban can be reached on 703-305-4385. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Duc Nguyen



July 8, 2004